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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/889,395	07/17/2001	Kazuma Niume	KOGYO-10	3972

7590 07/16/2003  
Donald W Huntley  
PO Box 948  
Wilmington, DE 19899-0948

EXAMINER

SHOSHO, CALLIE E

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 07/16/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/889,395

Applicant(s)

NIUME ET AL.

Examiner

Callie E. Shosho

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. All outstanding rejection except for those described below are overcome by applicants' amendment filed 4/24/03.

**Claim Rejections - 35 USC § 112**

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 7, 10, and 15 have been amended to recite "at least one compound selected from the group consisting of ammonia and a water-soluble amine or basic quaternary amine". Thus, the claims now recite improper Markush groups. It is suggested that the claims are rewritten as "at least one compound selected from the group consisting of ammonia, water-soluble amine, and basic quaternary amine".

**Claim Rejections - 35 USC § 102**

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Art Unit: 1714

5. Claims 1-4, 6, 8-18, and 21-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Kurachi et al. (U.S. 6,066,442).

The rejection is adequately set forth in paragraph 5 of the office action mailed 10/28/02, Paper No. 4, and is incorporate here by reference.

**Claim Rejections - 35 USC § 103**

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 7 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable Kurachi et al. (U.S. 6,066,442) in view of McHenry et al. (U.S. 4,113,507).

The rejection is adequately set forth in paragraph 8 of the office action mailed 10/28/02, Paper No. 4, and is incorporate here by reference.

**Response to Arguments**

8. Applicants' arguments regarding Kanbara et al. ("*Preparation of Electrically Conducting Indium-Tin Oxide Thin Films by Heat Treatment of Mixed-Metal Hydroxide Dispersion Containing Polymer Binder*") have been fully considered but they are moot in view of the discontinuation of this reference against the present claims.

9. Applicants' arguments filed 4/24/03 have been fully considered but, with the exception of arguments relating to Kanbara et al., they are not persuasive.

Specifically, applicants argue that Kurachi et al. is not a relevant reference against the present claims given that Kurachi et al. do not teach electro-conductive particles in an aqueous solution as presently claimed. Applicants argue that while Kurachi et al. disclose the use of stannic oxide (stannic acid) sol solution, there is no disclosure of aqueous solution as presently claimed.

However, it is noted that col.10, lines 31-33 of Kurachi et al. disclose that the electro-conductive particle are mixed in a solvent in which the conductive polymer is dissolved or dispersed and col.17, lines 26-31 disclose that such solvent includes water.

Further, the example in col.23, lines 28-49 discloses precipitating stannic chloride hydrate followed by adding the precipitate to water followed by addition of ammonia. This is the exact process used in the present invention for producing aqueous solution of stannic acid (see example 1 of the present specification for example). Thus, it is not clear why applicants argue that Kurachi et al. do not disclose aqueous solution of stannic acid as presently claimed. In light of the above, it would appear that the solution of stannic acid disclosed by Kurachi et al. is identical to the solution of stannous acid presently claimed. Clarification is requested.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 1714

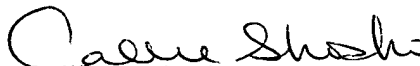
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 703-305-0208. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

CS  
July 11, 2003

  
Callie E. Shosho  
Primary Examiner  
Art Unit 1714